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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,803	09/26/2001	Iann Rance	18433/2042	9170

29933 7590 09/27/2002

PALMER & DODGE, LLP
KATHLEEN M. WILLIAMS
111 HUNTINGTON AVENUE
BOSTON, MA 02199

EXAMINER

SULLIVAN, DANIEL M

ART UNIT PAPER NUMBER

1636

DATE MAILED: 09/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/963,803	RANCE ET AL.	
	Examiner	Art Unit	
	Daniel Sullivan	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-42, drawn to a chimeric expression promoter, and an expression cassette, vector, host cells and transgenic plant comprising said chimeric expression promoter, and methods of using said chimeric expression promoter, wherein claims drawn to specific embodiments of the promoter are limited to the promoters set forth as MPr1116 (SEQ ID NO:3) and MPr1117 (SEQ ID NO:4) classified in class 800, subclass 298.
- II. Claims 1-42, drawn to a chimeric expression promoter, and an expression cassette, vector, host cells and transgenic plant comprising said chimeric expression promoter, and methods of using said chimeric expression promoter, wherein claims drawn to specific embodiments of the promoter are limited to the promoters set forth as MPr1146 (SEQ ID NO:5) and MPr1154 (SEQ ID NO:7) classified in class 800, subclass 298.
- III. Claims 1-42, drawn to a chimeric expression promoter, and an expression cassette, vector, host cells and transgenic plant comprising said chimeric expression promoter, and methods of using said chimeric expression promoter, wherein claims drawn to specific embodiments of the promoter are limited to the promoters set forth as MPr1147 (SEQ ID NO:6) classified in class 800, subclass 298.

- IV. Claims 1-42, drawn to a chimeric expression promoter, and an expression cassette, vector, host cells and transgenic plant comprising said chimeric expression promoter, and methods of using said chimeric expression promoter, wherein claims drawn to specific embodiments of the promoter are limited to the promoters set forth as MPr1162 (SEQ ID NO:19), MPr1163 (SEQ ID NO:20) and MPr1165 (SEQ ID NO:22) classified in class 800, subclass 298.
- V. Claims 1-42, drawn to a chimeric expression promoter, and an expression cassette, vector, host cells and transgenic plant comprising said chimeric expression promoter, and methods of using said chimeric expression promoter, wherein claims drawn to specific embodiments of the promoter are limited to the promoters set forth as MPr1164 (SEQ ID NO:21) classified in class 800, subclass 298.
- VI. Claims 1-42, drawn to a chimeric expression promoter, and an expression cassette, vector, host cells and transgenic plant comprising said chimeric expression promoter, and methods of using said chimeric expression promoter, wherein claims drawn to specific embodiments of the promoter are limited to the promoters set forth as MPr1167 (SEQ ID NO:23), MPr1168 (SEQ ID NO:24) and MPr1169 (SEQ ID NO:25) classified in class 800, subclass 298.

The inventions are distinct, each from the other because of the following reasons:

The Inventions are drawn to products and methods comprising patentably distinct chimeric expression promoters. The promoters that distinguish the Inventions comprise a set

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functional elements uniquely arranged such that the promoters are structurally and functionally distinct. For example, the promoter of Group I comprises the elements "as1 like"- "as1", in that order, while the promoter of Group II comprises the elements "as2"- "as1"- "as1". Because these inventions are distinct for the reasons given above and the search required for each of the patentably distinct promoter sequences is unique, restriction for examination purposes as indicated is proper.

Claims 1, 6 and 23 link(s) inventions I-VI. The restriction requirement among linked inventions is subject to the nonallowance of the linking claim(s), claims 1, 6 and 23. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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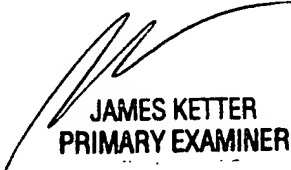
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 703-305-4448. The examiner can normally be reached on Monday through Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-9105 for regular communications and 703-746-9105 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

dms
September 25, 2002



JAMES KETTER
PRIMARY EXAMINER